

**REMARKS****I. General**

Claims 1-18 are pending in the present application. The outstanding issues in the current Office Action are as follows:

Claims 2, 9, and 10 are objected to as being dependent upon a rejected base claim, but are allowable if rewritten in independent form including the limitations of the base claims and any intervening claims.

Claims 1, 6-8, and 13-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2005/0080736 A1 (hereinafter, *Dent*) in view of U.S. Patent No. 5,890,189 (hereinafter, *Nozue*).

Claims 3-5, and 11-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dent* in view of *Nozue* and further view of U.S. Patent No. 5,446,796 (hereinafter, *Ginya*).

Applicant respectfully requests withdrawal of the rejections in light of the amendments and remarks contained herein.

**II. Rejections Under 35 U.S.C. §103(a)**

The Office Action is improper because the Examiner has not complied with the mandates of *Graham v. John Deere and Co.* The test for non-obvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in *Graham v. John Deere and Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art, and (4) evaluate evidence of secondary considerations. See M.P.E.P. §2141.

The M.P.E.P. § 706.02(j), incorporates the mandate of *Graham v. John Deere* and directs the Examiner to set forth in the Office action: (1) the relevant teachings of the prior art relied upon; (2) the difference or differences in the claim over the applied references; (3) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and (4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The rejection of claims 5-7, and 12-18 as stated in the Office Action does not meet the requirements set forth above. In particular, the rejection of claims 5-7, and 12-18 as stated in the Office Action does not set forth the relevant teachings of the prior art relied upon for these limitations, or the difference in the claim over the applied references, or the proposed modification of the applied references necessary to arrive at the claim subject matter, or an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. Therefore, the rejection of claims 5-7, and 12-18 is improper and should be withdrawn, and claims 5-7 and 12-18 should be indicated as allowable over the art of record.

**A. Rejections over *Dent* in view of *Nozue***

Claims 1, 6-8, and 13-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dent* in view of *Nozue*. Applicant traverses the rejection and asserts the claims are allowable, at least, for the reasons stated below.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143. Applicant respectfully asserts that the rejection of record does not satisfy these requirements.

Claim 1 recites, in part “a memory storing a plurality of payment and non-payment applications.” The Examiner asserts that this limitation is disclosed in the Abstract, lines 1-9

of *Dent* “specifically wherein said the bill is stored in memory with other unpaid electronic bill. Please note that unpaid also includes non-payment bill.” Office Action pages 2-3. The Examiners assertion is incorrect because the Abstract recites “[a] consumer-based bill management and payment system configured to receive, analyze, manage and pay electronic billing statements received from the biller over the internet.” The received bill, which is unpaid until the system pays it, is part of the consumer-based bill management and payment system configured to receive the unpaid bill, analyze, manage and ultimately pay the unpaid bill. Page 2, paragraph 0017. Assuming *arguendo* that the bill management and payment system is a payment application, the unpaid bill is part of a payment application. An unpaid bill in *Dent* is not a non-payment application as asserted by the Examiner. Thus, *Dent* does not teach or suggest this limitation, nor does the Examiner cite to *Nozue* to teach or suggest this limitation. Therefore, Applicant respectfully asserts that the combination of *Dent* and *Nozue* does not teach or suggest this limitation as required for a proper rejection under 35 U.S.C. § 103.

Claim 1 also recites “a memory management unit for separating said applications in said memory, thereby permitting said non-payment applications to exist with said payment application without requiring additional certification.” The Examiner asserts that *Dent* discloses “a memory management unit for separating said application in said memory, thereby permitting said payments” (Office Action page 3) and cites to the *Dent* Abstract, Figure 2, item 48 and pages 2-5 as disclosing this limitation. However, *Dent* does not disclose this limitation. The abstract only states that “the bill is stored in memory with other unpaid electronic bills.” Clearly, storing a bill in the memory with other unpaid electronic bills is not the same as “a memory management unit for separating said applications in said memory, thereby permitting said non-payment applications to exist with said payment applications without requiring additional certification.” Figure 8, item 48 also fails to meet the claim language. Instead, it shows a bill management application with three components described as “three software modules: a notification manager, a cashflow analyzer, and a payment analyzer.” Page 3, paragraph 0042. *Dent* does not describe separating the applications in the memory or permitting the applications to exist without requiring additional certification. Thus, *Dent* does not teach or suggest “a memory management unit for

separating said applications in said memory, thereby permitting said non-payment applications to exist with said payment application without requiring additional certification,” nor does the Examiner assert that *Nozue* teaches or suggests this limitation in the rejection of record. Therefore, Applicant respectfully asserts that the combination of *Dent* and *Nozue* do not teach or suggest this limitation as required for a proper rejection under 35 U.S.C. § 103.

Claim 1 further recites “said payment applications are operable to provide payment related services over a secured network and said non-payment applications operable to provide non-payment related services over an open network.” The Examiner fails to address this limitation in his rejection of claim 1. Therefore, the rejection is improper because all of the limitations of the claim “must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. §2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Accordingly, with respect to the arguments set forth above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

Claim 8 recites, in part, “storing a plurality of payment and non-payment applications in separate memory locations within said terminal, thereby permitting said non-payment applications to exist with said payment application without requiring additional certification.” The Examiner asserts that *Dent* discloses “a memory management unit for separating said application in said memory, thereby permitting said payments” (Office Action page 3) and Examiner cites to the *Dent* Abstract, Figure 2, item 48 and pages 2-5. However, *Dent* does not disclose this limitation. The abstract only states that “the bill is stored in memory with other unpaid electronic bills.” Clearly, storing a bill in the memory with other unpaid electronic bills is not the same as the limitation of claim 8, which recites “storing a plurality of payment and non-payment applications in separate memory locations within said terminal.” Figure 8, item 48 does not meet the claim language either, instead it shows a bill management application with three components described as “three software modules: a notification manager, a cashflow analyzer, and a payment analyzer.” Page 3, paragraph 0042. Thus, *Dent* does not teach or suggest “storing a plurality of payment and non-payment applications in separate memory locations within said terminal, thereby permitting said non-payment applications to exist with said payment application without requiring additional certification,” nor does the Examiner assert that *Nozue* teaches or suggests this limitation in

the rejection of record. Therefore, Applicant respectfully asserts that the combination of *Dent* and *Nozue* do not teach or suggest this limitation as required for a proper rejection under 35 U.S.C. § 103.

Claim 8 also recites “wherein said payment applications provide payment related services over a secured network and said non-payment applications provide non-payment related services over an open network.” The Examiner fails to address this limitation in his rejection of claim 8. Therefore, the rejection is improper because all of the limitations of the claim “must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. §2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Accordingly, with respect to the arguments set forth above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

The Examiner’s rejection of claim 15 is improper under *Graham v. John Deere* as discussed above. The discussion of claim 1 in the Office Action does not address any of the limitations of claim 15. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

#### **No Motivation to Combine *Dent* with *Nozue***

The Examiner asserts that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the consumer-based bill management of *Dent* by including the limitation detailed above as taught by *Nozue* (a management unit that can provide memory protection information that is assigned in advance to each region) because this would monitor a buyer who has paid a seller and the seller has failed to deliver the goods or service properly.” Office Action, page 3. Applicant respectfully asserts that the meaning of the statement is unclear, but Applicant will try to address the statement as best as possible. Assuming *arguendo* that *Nozue* teaches a memory management unit that is operable to assign a protected region within the memory to each application being executed by the processor, Applicant asserts that modifying *Dent* (a bill management application) by combining with *Nozue* (a memory management unit that is operable to assign a protected region within the memory to each application) as suggested by the Examiner would not

enable a buyer to monitor a seller who has failed to deliver goods or services. Therefore, Applicant respectfully asserts that the Examiner fails to establish a prima facie case of obviousness under 35 U.S.C. § 103 because the purported motivation is not achieved by the combination as suggested. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

Claims 6-7, 13-14, and 16-18 depend either directly or indirectly from, and inherit all of the limitations of, independent claims 1, 8, and 15, shown above to be allowable over the applied art. Therefore, claims 6-7, 13-14, and 16-18 are allowable, at least because of their dependence from claims 1, 8, and 15 respectively.

Moreover, the Examiner failed to meet the mandates of *Graham v. John Deere* with respect to the limitations in claims 6-7, 13-14, and 16-18 in the Office Action. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

**Rejections over *Dent* in view of *Nozue* and further in view of *Ginya***

Claims 3-5, and 11-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dent* in view of *Nozue* and in further view of *Ginya*. Applicant traverses the rejections and asserts the claims are allowable, at least, for the reasons stated below.

Claims 3-5, and 11-12 depend either directly or indirectly from, and inherit all of the limitations of, independent claims 1, and 8 shown above to be allowable over the applied art. Further, *Ginya* does not cure the deficiencies of the rejections noted above. Therefore, claims 3-5, and 11-12 are allowable, at least because of their dependence from claims 1 and 8 respectively.

Moreover, the Examiner failed to meet the mandates of *Graham v. John Deere* with respect to the limitations in claims 5 and 12 in the Office Action. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

**III. Conclusion**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10013451-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482725883US in an envelope addressed to: Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: November 2, 2005

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